

**REMARKS**

The above amendments and following remarks are responsive to the points raised in the May 5, 2004 non-final Office Action. Upon entry of the above amendments, Claims 1, 2, 14, 21, 22, 32, 34, 38, 40, and 42 will have been amended, Claims 18, 19, 27, and 28 will have been canceled, and Claims 1-17, 20-26, and 29-45 will be pending. Claims 8-13, 20, 29-31, 33, 35-37, 39, 41, and 43-45 have been withdrawn from consideration as being drawing to non-elected species. No new matter has been introduced. Entry and reconsideration are respectfully requested.

**Response to Election/Restriction Requirement**

Applicant has been required to elect one of the following six distinct species:

“First Species: figures 1-4

Second Species: figures 5-8

Third Species: figures 9-10

Fourth Species: figures 11-13

Fifth Species: figures 14-16

Sixth Species: figures 17-18”.

Upon election of one of the above-identified species, Applicant has also been required to provide a listing of all of the claims readable thereon.

On March 16, 2004, the Examiner provided Applicant with a facsimile copy of the election of species requirement. An oral election of the First Species, i.e., Figures 1-4, was elected on April 20, 2004. Claims 1-7, 14-19, 21-28, 32, 34, 38, 40, and 42 were identified as being directed to the elected species.

**Response to Objection to the Specification**

The specification has, in effect, been objected to on the basis that the title is not descriptive. A new title “that is indicative of the invention to which the claims are directed” has been required.

Applicant has amended the title of the invention in accordance with the Examiner’s requirement. As such, the objection is now moot and should be withdrawn. Should the Examiner continue the objection, the Examiner is requested to suggest an acceptable title.

**Rejection Under 35 U.S.C. § 102(b):**

Claims 1-7, 14-16, 21-25, 32, 34, and 38 have been rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,703,638 to Ohta. Applicant respectfully traverses this rejection.

Amended independent Claims 1 and 21 have been amended to incorporate subject matter originally introduced in original dependent Claims 18, 19, 27, and 28, which have now been canceled and were not rejected as being anticipated by Ohta. As such, Claims 1 and 21 recite an image sensing apparatus having, inter alia, an image processing device for performing moving image signal processing and still image signal processing, wherein:

“when said still image signal processing is to be executed, said signal processing device performs predetermined control when said optical transparent member has a focal length within a predetermined range of focal length, said predetermined control being not performed when said moving image signal processing is to be executed” (Claim 1), and

“when said still image signal processing is to be executed, said signal processing device applies predetermined limitation when said optical transparent member has a focal length within a predetermined range of focal length, said predetermined limitation being not applied when said moving image signal processing is to be executed” (Claim 21),

Likewise, rejected independent Claims 32, 34, and 38 include language consistent with the above language of Claims 1 and 21. More specifically, Claims 32 and 34 recite control methods of an image sensing apparatus wherein “predetermined control is performed when said optical

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transparent member has a focal length within a predetermined range of focal length” (Claim 32) and “predetermined limitation is applied when said optical transparent member has a focal length within a predetermined range of focal length” (Claim 34). Claim 38 recites a method of designing an optical system for recording moving and still images:

“wherein optical property of the optical system is designed allowable for recording the moving image whereas not allowable for recording the still image when said optical transparent member has a focal length within a predetermined range of focal length.”

Applicant respectfully submits that Ohta neither teaches nor suggests performing, or applying, a predetermined control, or limitation, by the signal processing device, when said optical transparent member has a focal length within a predetermined range of focal length, as recited in Claims 1, 21, 32, and 34. Ohta neither teaches nor suggests designing an optical system for recording both moving and still images where the optical system will not allow the recording of still images when the optical transparent member has a focal length within a predetermined range of focal length.

The Examiner’s comments, with respect to Claims 1, 21, 32, and 34, do not point out or discuss how or where Ohta teaches or suggests performing, or applying, a predetermined control, or limitation, by the signal processing device, in response to movement of the optical transparent member to a predetermined position, or range of focal length. Rather, the Examiner urges that:

“when still image signal processing is to be executed a predetermined control is performed or a predetermined limitation is applied in response to movement of actuators that drive the optical transparent member (col. 7, lines 13-32).”

In regard to Claim 38, the Examiner urges that:

“In the still image shooting mode a check is made to find if the AWB control is in a transition period. If it is in a transition period, the shutter operation period is inhibited and the still image is prevented from being recorded (col. 7, lines 21-46). Therefore, the optical system is designed allowable for recording the moving image and not allowable for recording the still image upon movement of the optical transparent member to a predetermined position.”

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Ohta, in Column 7, Lines 13-46, states:

“The flow of the operation procedures to be taken within the shutter control device 320 of FIG. 7 is similar to the flow shown in FIG. 4. However, the details of the process of the shutter control routine to be executed for still image shooting at the step 408 differ from the first embodiment. The details of this shutter control routine for still image shooting are described below with reference to FIG. 8 which is a flow chart:

At a step 700: The above-stated AWB control state signal is checked to find if the state of change taking place in the AWB control is above a given level. In other words, a check is made to find if the AWB control is in a transition period. If so, the flow of control is inhibited from coming to a next step 702 which is a shutter driving routine until the AWB control comes to an end. If the AWB control is judged to be in a normal state at the step 700, the flow comes to the step 702 for the shutter driving routine. At the step 702: When still image shooting is judged to be possible, the still image shooting is carried out by driving the shutter 306 at a predetermined shutter speed.”

“The second embodiment is thus arranged to monitor the AWB control state when a release button (or device) is turned on in the still image shooting mode; and to inhibit the shutter operation if the AWB control is in a transition period. Therefore, a still image can be prevented from being recorded in an inapposite state when a color on the image plane differs from the actual color of the object. In other words, with the second embodiment arranged to inhibit a release action for still image shooting according to the AWB control state, the color of the still image is effectively prevented from differing from the actual color. The arrangement enable the video camera of the kind capable of recording both moving and still images to ensure sharp still image shots.”

Here, Ohta discloses that the flow of operation procedures of the shutter control device 320 of Figure 7 is similar to the flow shown in Figure 4, while the details of the process of the shutter control routine for still image shooting follow the flow shown in Figure 8. In Step 700, of Figure 8 of Ohta, the ABW (automatic white balance) control state signal is checked to find if the AWB control is in a transition period, and is so, the shutter drive routine of Step 702 is inhibited until the AWB control has ended. When the AWB control is determined to be in a normal state, Ohta discloses that flow comes to Step 702 for the shutter drive routine, where still image shooting is carried out when still image shooting is determined to be possible. No where in the above words of Ohta is it seen where Ohta either teaches or suggests performing, or applying, a predetermined

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control, or limitation, by the signal processing device, in response to movement of the optical transparent member to a predetermined position, or range of focal length.

Ohta, with respect to Figure 5, Column 6, Lines 3-57, discusses the details of a shutter control routine (Step 408 of Figure 4) for shooting still images, which include a check to determine whether or not the optical system actuators are in action. When no action of the optical system actuators is found, Ohta discloses still image shooting is carried out. However, when action of the optical system actuators is detected, such as, when either the focusing lens group 300 or the zooming lens group 302 is moving, Ohta discloses that the moving lens group 300 or 302 is stopped prior to still image shooting being carried out. As such, Ohta is concerned with stopping mere movement of the lens groups 300 or 302 when such movement is detected just prior to still image shooting. Ohta, however, does not teach or suggest detecting movement of either of the lens groups 300 or 302 to a predetermined position, or range of focal length.

In view of the above detailed discussion, the subject matter recited in any one of independent Claims 1, 21, 32, 34, and 38 are distinguished over the applied prior art reference of Ohta. Dependent Claims 2-7, 14-17, and 22-25 are likewise distinguished over Ohta for at least the same reasons as their respective base Claims 1 and 21. As such, the rejection under 35 U.S.C. § 102(b) should be withdrawn.

Applicant respectfully submits that dependent Claims 8-13, which have been withdrawn from consideration for being directed to a non-elected species, are dependent upon independent Claim 1. As such, non-elected Claims 8-13 are distinguished over Ohta for at least the same reasons discussed above in regard to Claim 1. Upon withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of Claim 1, non-elected Claims 8-13 should be rejoined and likewise allowed by the Examiner.

Amendment**Response to Rejections under 35 U.S.C. 103(a)**

Claims 17 and 26 have been rejected under 35 U.S.C. § 103(a) as being obvious over Ohta as applied to Claims 1 and 21 in view of US Patent 6,348,940 to Sano et al. (Sano). Claims 18, 19, 27, and 28 have been rejected under 35 U.S.C. § 103(a) as being obvious over Ohta as applied to Claims 1 and 21 in view of US Patent 5,875,359 to Ohtake et al. (Ohtake). Claims 40 and 42 have been rejected under 35 U.S.C. § 103(a) as being obvious over Ohta. Applicant respectfully traverses these rejections.

In regard to Claims 17 and 26, the Examiner admits that the primary reference of Ohta does not teach each feature of the invention as recited therein. More specifically, the Examiner admits that Ohta does not disclose an optical transparent member comprising an optical filter. The Examiner therefore, attempts to rely on the secondary teaching of Sano to remedy the deficiencies of Ohta. The Examiner urges that the secondary reference of Sano discloses, inter alia, an optical filter and a filter driving circuit. On this basis, the Examiner concludes that:

“it would have been obvious for one skilled in the art to have been motivated to include the optical filter and filter driving circuit as taught in Sano in the magnetic recording apparatus as disclosed by Ohta. Doing so would provide a means for controlling still image processing in response to the movement of an optical filter that is driven by a filter drive circuit (Sano: col. 5, lines 27-29).”

Notwithstanding the admitted difference, Claims 17 and 26, respectively, depend upon independent Claims 1 and 21, which, as discussed above, are distinguished over Ohta on the basis of their recitation of performing, or applying, a predetermined control, or limitation, by the signal processing device, in response to movement of the optical transparent member to a predetermined position. Due to their respective dependencies on Claims 1 and 21, Claims 17 and 26 include all of the limitations of Claims 1 and 21, respectively, and are therefore further distinguished over Ohta for at least the same reasons as Claims 1 and 21. No where is it seen in the disclosure of Sano, where Sano would have taught, suggested, or motivated one of ordinary skill in the art, at the time the invention was made, to have modified the primary teaching of

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Ohta as suggested by the Examiner, to arrive at the subject matter recited in dependent Claims 17 and 26. On this basis, the subject matter of Claims 17 and 26 is distinguished over Ohta and Sano, either alone or in combination. According, the rejection of Claims 17 and 26 under 35 U.S.C. § 103(a) over Ohta as applied to Claims 1 and 21 in view of Sano should be withdrawn.

In regard to now canceled Claims 18, 19, 27, and 28, from which subject matter originally introduced therein has been included in amended Claims 1 and 21, the Examiner admits that the primary reference of Ohta does not teach each feature of the invention as recited therein. More specifically, the Examiner admits that Ohta does not “distinctly state that a predetermined focal length state or focus position state is determined based on movement of the optical transparent member to a predetermined position.” The Examiner therefore, attempts to rely on the secondary teaching of Ohtake to remedy the deficiencies of Ohta. The Examiner urges that the secondary reference of Ohtake discloses, inter alia, a zoom lens system having predetermined focal length and focus positions. On this basis, the Examiner concludes that:

“it would have been obvious for one skilled in the art to have been motivated to include the focusing lens system including predetermined focal length or focus position states as taught by Ohtake in the magnetic recording apparatus including focus control as disclosed by Ohta. Doing so would provide a means for obtaining a predetermined focal length state for the focus control based on the movement of the optical transparent member (Ohtake: col. 2, lines 32-37).”

No where is it seen where Ohtake would have taught, suggested, or motivated one of ordinary skill in the art, at the time the invention was made, to have modified the primary teaching of Ohta as suggested by the Examiner, to arrive at the subject matter recited in dependent Claims 18, 19, 27, and 28. On this basis, the subject matter of Claims 18, 19, 27, and 28 is distinguished over Ohta and Ohtake, either alone or in combination. According, the rejection of the subject matter introduced by original dependent Claims 18, 19, 27, and 28 under 35 U.S.C. § 103(a) over Ohta in view of Ohtake should be withdrawn.

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In regard to Claims 40 and 42, the Examiner admits that the primary reference of Ohta does not teach each feature of the invention as recited therein. More specifically, the Examiner admits that Ohta does not disclose “that a computer program is applied for the image sensing apparatus including program codes.” The Examiner therefore, urges and concludes that:

“Ohta is a microprocessor-based system (col. 5, lines 23-38), therefore it would have been obvious to include a computer program including program codes for carrying out this operation.”

Notwithstanding the admitted differences between Claims 40 and 42, these claims include subject matter consistent with the distinguishing features discussed above with respect to Claims 1, 21, 32, 34, and 38. More specifically, the subject matter recited in Claims 40 and 42 include:

“wherein, when said still image signal processing is to be executed, predetermined control is performed when said optical member has a focal length within a predetermined range of focal length, said predetermined control being not performed when said moving image signal processing is to be executed.” (Claim 40), and

“wherein, when said still image signal processing is to be executed, predetermined limitation is applied when said optical member has a focal length within a predetermined range of focal length, said predetermined limitation being not applied when said moving image signal processing is to be executed” (Claim 42).

Applicant respectfully submits that Ohta neither teaches nor suggests performing, or applying, a predetermined control, or limitation, when said optical member has a focal length within a predetermined range of focal length as recited in Claims 40 and 42. Such recitation is consistent with the language discussed above distinguishing Claims 1, 21, 32, 34, and 38 over the teaching of Ohta. No where is it seen within the disclosure of Ohta, where Ohta teaches, suggests, or otherwise renders obvious the subject matter as recited in Claims 40 and 42. As such, the subject matter of Claims 40 and 42 are distinguished over the prior art teaching of Ohta. According, the rejection of Claims 40 and 42 under 35 U.S.C. § 103(a) over Ohta should be withdrawn.



**CONCLUSION**

Applicant respectfully submits that Claims 1-17, 21-26, 32, 34, 38, 40, and 42 are in condition for allowance and a notice to that effect is respectfully solicited.

**AUTHORIZATIONS**

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-4647.

Respectfully submitted,  
MORGAN & FINNEGAN, D.L.P.

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By: 

Brian W. Brown

Reg. No.: 47,265

(202) 857-7887 Telephone

(202) 857-7929 Facsimile

**Correspondence Address:**  
Morgan & Finnegan  
Three World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile